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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/618,321
Filing Date: July 18, 2000
Appellant(s): ABRAHAMS, MARC DAVID

Richard E. Wawrzyniak, Reg. No. 36,048
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 21, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1 – 22 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). Because Applicant failed to include the statement of grouping of the claims, Examiner treated these claims as stand and fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,848,399	Burke	12-1998
5,237,157	Kaplan	08-1993

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 – 22 are rejected under 35 U.S.C. 103 (a). The rejection is set forth in prior Office Action, Paper No. 9.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,848,399 issued to Raymond Burke ("Burke") and in view of U.S. Patent Number 5,237,157 issued to Joshua Kaplan ("Kaplan").

With respect to claims 1 and 12, Burke teaches retrieving data for a particular user from a database (column 3, lines 49 – 53, column 6, lines 50 – 60, column 11, lines 64 – 67 and column 12, lines 40 – 67;

means for retrieving, through the means for accessing the data file, the information describing the locations and dimensions of the products in three dimensions and dimensions of the display area in three dimensions for the selected product category, means for retrieving, through the means for accessing the product image database and using the unique code for each product in the selected product category, the image for each product in the selected product category, . . .);

assembling display data that is configured to render a three-dimensional display area on a video display, the display area including images of one or more products that are selected based on the data (column 5, lines 15 – 26;

The images and price information 54 from the image database 50 and three-dimensional description 56 for a store 59 from the store database 61 are used by a shopping service 65, which operates on a multi-server computer. The shopping service (and therefore, the multi-server computer) 65 is connected to a consumer's access system 64 via a connection 63. A video display generator 58, part of the shopping service 65, generates a picture 60 which is transmitted to the display 71 of the consumer's access system 64);

sending the display data through a computer network for display on a client computer video display (column 5, lines 15 – 24

The images and price information 54 from the image database 50 and three-dimensional description 56 for a store 59 from the store database 61 are used by a shopping service 65, which operates on a multi-server computer. The shopping service (and

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therefore, the multi-server computer) 65 is connected to a consumer's access system 64 via a connection 63. A video display generator 58, part of the shopping service 65, generates a picture 60 which is transmitted to the display 71 of the consumer's access system 64);

receiving a communication from the client computer through the computer network, the communication resulting from interactions with the display area (column 5, lines 46 – 60;

the multi-server computer may communicate with a personal computer, which acts as the consumer's access system 64. The consumer's input device 70 may be any of a mouse, trackball, keyboard, touch screen or other input device for a computer. The consumer's display 71 is typically a cathode ray tube or other type of computer display for the personal computer. The consumer accesses the shopping service 65 running on the multi-server computer via a modem and telephone line, which provides the connection 63 between the multi-server 65 and the consumer's access system 64. This system may also be operating on a multi-user computer system, where a main multi-server computer running the shopping service 65 is accessible by multiple consumers using other computers via a computer network); and

updating the data for the particular user in the database based on the communication (column 11, lines 48 – 63 and column 12, lines 21 – 22;

Research data is also accumulated and stored during the processing of consumer actions. For each action taken by the consumer, a date and time stamp, an indication of the action taken, and an indication of the product affected may be stored. For example, each purchase, or each time a product is removed from the consumer shopping cart in either of steps 167 or 171 can be stored as an event which may have some marketing research significance. The number of products purchased, their frequency over time and the ordering of choices provides insight into the purchasing behavior of the consumer. From these stored actions and time stamps, one may also determine the amount of time a consumer has taken for given actions. For example, the amount of time a consumer views a product close-up, or views a

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particular product category, may be determined. This timing gives an indication as to how long a user takes to make a decision. All ordering information and other consumer actions are automatically tracked).

Burke teaches retrieving and updating data for a user from a database. Burke does not explicitly teach personalization data as claimed. But, Burke teaches frequency of products purchased and the purchasing behavior of the consumer.

Kaplan teaches claimed personalized (profile) data (see abstract and column 3, lines 39 – 46; column 5, lines 42 – 44; Kaplan:

After subscriber selection, a programmable data processor selects from storage and then transmits at least one discrete increment of information to a display means for subscriber review. Subscriber selection and profile data are collected and stored. The invention also provides for transmission of subscriber selection and subscriber profile data to a central database for collection and processing by the central processing unit. This system is used to preview audio programs on compact disks. The selection and input data from the subscriber is collected from each kiosk location and is transmitted to be stored in a central database for analysis by the central processing unit. Through the central processing unit, the subscriber selection and subscriber profile data can be analyzed, packaged, and distributed as information products to the entire music industry as timely and focused market research . . .).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was to combine Kaplan with Burke because the combination would provide a system to be a computer age listening booth. Consumers would be offered the ability to preview music before purchasing selections at record store (column 3, lines 47 – 52; Kaplan).

As to claims 2 and 13, an instruction to select one of the product images in the display area (column 7, lines 59 – 63 and column 12, lines 1 – 5).

As to claims 3 and 14, an instruction to manipulate one of the product images in the display area (column 6, lines 40 – 43).

As to claims 4 and 15, assembling modified display data that is configured to render a modified display area having at least a portion of a selected one of the product images shown in more detail (column 6, lines 40 – 48).

As to claims 5 and 16, sending the modified display data through the network for display on the client computer (column 6, lines 43 – 48).

As to claims 6 and 17, processing data included in the communication with a engine (column 9, lines 13 – 29).

As to claims 7 and 18, a request for an audio file (column 1, lines 63 – 66).

As to claims 8 and 19, sending an audio file through the computer network to the client computer (column 1, lines 63 – 66).

As to claims 9 and 20, the communication comprises one or more search terms (column 5, lines 38 - 42).

As to claims 10 and 21, the display area comprises an input box configured to receive search terms (column 5, lines 38 – 47).

As to claims 11 and 22, the display area comprises a virtual room (column 12, lines 1 – 9).

(11) Response to Argument

Appellant's arguments regarding the rejection of claims 1 – 22:

Argument No. 1: Burke in view of Kaplan, taken as a whole, does not suggest appellant's claimed use of personalized data (Page 5, The Fourth Paragraph, Brief).

Argument No. 2: The alleged personalization features allegedly disclosed in Kaplan cannot be properly combined with the system disclosed in Burke (Page 9, The Second Paragraph, Brief).

Argument No. 3: Burke does not teach processing data included in a communication with a personalized engine (Page 13, The Second Paragraph, Brief).

Examiner's Response to Arguments:

In response to Argument No. 1:

As per Appellant's argument that "Burke in view of Kaplan, taken as a whole, does not suggest appellant's claimed use of personalized data." It appears that Appellant has relied on the claim limitation, "... personalization data . . .", see claim 1.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

MPEP 2111 Claim Interpretation; Broadest Reasonable Interpretation

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more

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broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim.). See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

Burke allows a consumer to purchase products from home. The system generates an image representative of a store shelf, which is displayed to a consumer (see summary on column 2). Research data is also accumulated and stored during the processing of consumer actions. For each action taken by the consumer, a date and time stamp, an indication of the action taken, and an indication of the product affected may be stored. For example, each purchase, or each time a product is removed from the consumer shopping cart can be stored as an event which may have some marketing

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research significance. The number of products purchased, their frequency over time and the ordering of choices provides insight into the purchasing behavior of the consumer (user's personalized information). A computer system for enabling a user to virtually manipulate products in three dimensions, (as described in the Applicant's specification on page 8, lines 12 – 36) comprising: means for receiving an indication from the user of a selected product category of the plurality of product categories, means for retrieving, through the means for accessing the data file, the information describing the locations and dimensions of the products in three dimensions and dimensions of the display area in three dimensions for the selected product category (column 11, lines 48 – 58 and column 12, lines 40 – 63; Burke).

Kaplan teaches that a program similar to an airline frequent flyer club can be generated. The central database can maintain a library of subscribers with subscriber profile information (user's personalized information) and specific preview activity (column 5, lines 41 – 44).

Kaplan teaches a user-interactive multimedia based point-of-preview system (an interactive digital music sampling kiosks). The consumer as a subscriber is put in contact with his purchases by having offered the ability to preview music before purchasing selections at record stores (see summary on column 2).

As per Appellant's arguments that "nothing in Kaplan that discloses that images of one of or more products are selected based on the profile data for a particular user", examiner maintains that Kaplan's "subscriber profile" element clearly indicates objects being selected based on the habits of users via a Kiosk.

As per Appellant's arguments that "Kaplan does not disclose a display area including 'images of one or more products that are selected based on the personalization data", examiner maintains that Kaplan's Kiosk screen and Burke Virtual element are synonymous to applicant's display area teachings. Further Kaplan's selections via the Kiosk, along with the profile element, is illustrative of applicant's teaching of products being selected based on personalization data.

In response to Argument No. 2:

In response to Appellant's argument that "the alleged personalization features allegedly disclosed in Kaplan cannot be properly combined with the system disclosed in Burke." The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's argument on page 9, a prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

Burke teaches retrieving and updating data for a user from a database. Burke does not explicitly teach personalization data as claimed. But, Burke teaches frequency of products purchased and the purchasing behavior of the consumer.

Kaplan teaches claimed personalized (profile) data (see abstract and column 3, lines 39 – 46; column 5, lines 42 – 44).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was to combine Kaplan with Burke because the combination would provide a system to be a computer age listening booth. Consumers would be offered the ability to preview music before purchasing selections at record store (column 3, lines 47 – 52; Kaplan).

Therefore, examiner concludes that Burke and Kaplan's invention are similar and are combinable.

In response to Argument No. 3:

In response to Appellant's argument that "Burke does not teach processing data included in a communication with a personalized engine."

Examiner maintains that Burke's teaching of a computer system for enabling a user to virtually manipulate (process) products in three dimensions (column 12, lines 40 – 41), as described in the Applicant's specification on page 8, lines 12 – 36 and combined with Kaplan's profile element, clearly teachings and reads on a personalization engine in a manner similar to applicant's claim language. Furthermore,


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Kaplan teaches that a program similar to an airline frequent flyer club can be generated.

The central database can maintain a library of subscribers with subscriber profile information (user's personalized information) and specific preview activity (column 5, lines 41 – 44).

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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February 9, 2004

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